

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gack et al.
Title: USE OF ADAM 12 FOR DIAGNOSIS AND
THERAPY OF PREECLAMPSIA
Appl. No.: 10/576,266
International Filing Date: 10/15/2004
371(c) Date: 12/20/2006
Examiner: Haddad, Maher M.
Art Unit: 1644
Confirmation Number: 3606

**REQUEST FOR RECONSIDERATION OF PATENT
TERM ADJUSTMENT UNDER 37 C.F.R. §1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on November 30, 2010 as U.S. Patent No. 7,842,464 B2. If a request for reconsideration is not appropriate, then this present request is a petition under 37 CFR sections 1.181, 1.182, and 1.183.

Applicants have calculated PTA for the captioned patent, and have determined that the patent is entitled to 735 days of PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	823 days
(b) Total Applicant delay:	88 days
Final PTA Determination:	735 days

Applicants believe the PTO's position of counting all days between the filing of a Notice of Appeal on December 16, 2009 and the mailing of a Notice of Allowance on July 23, 2010 under 37 CFR 1.703(b)(4) is not proper. 37 CFR 1.703(b)(4) interprets 35 USC 154(b)(1)(B)(ii), which provides that the guarantee of no more than 3-year pendency does not include "any time consumed by appellate review by the Board." 37 CFR 1.702(b)(4) contains parallel language. Although 37 CFR 1.703(b)(4) appears to implement these provision by counting the number of days "beginning on the date on which a Notice of Appeal to the Board was filed," this rule over counts days, because the filing of a Notice of Appeal does not commence the time period of appellate review by the Board. To the contrary, as set forth in 37 CFR 41.35, jurisdiction does not pass to the Board until after all briefs and the examiner's answer have been issued, at which time the Technology Center transmits the file to the Board. Until then, there is no "appellate review by the Board," and the examiner maintains jurisdiction, for example, to reopen prosecution or issue a notice of allowance.

In this application, there was no appellate review by the Board; no Brief on Appeal was ever filed. The Notice of Appeal was filed to maintain pendency while the examiner considered Applicants' concurrently filed response, and the next action an Advisory Action, Applicants response, and then a Notice of Allowance on July 23, 2010, which closed prosecution. Thus, the 220 days between the filing of a Notice of Appeal on December 16, 2009, and the issuance of the Notice of Allowance on July 23, 2010, was in no way related to appellate review by the Board, and so 35 USC 154(b)(1)(B)(ii) does not justify excluding these days from the 3-year pendency calculation.

35 USC 154(b)(1)(B)(ii) provides for patent term adjustment when issuance is delayed due to "appellate review by the Board . . . in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability." Because there was no appellate review, let alone a reversal of a rejection, this statute is inapplicable here.

Applicants therefore respectfully request that the Patent be accorded 735 days PTA.

The patent is not subject to a terminal disclaimer.

The fee for this request is enclosed via EFS-web. Any deficiency in fees may be charged to Deposit Account 19-0741.

Respectfully submitted,

Date: January 31, 2011

By /Michele M. Simkin/

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Docket Number: 097147-0106

Application Number: 10/576266

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	10/17/2003	-913		
Edit Delete	International Filing Date	10/15/2004	-549		
	PCT National Stage Commencement Date	04/17/2006	0		
Edit Delete	National Stage Entry (All 371(c) & (f) Requirements Met)	12/20/2006	247		
	14 month From Application date	02/20/2008	674		
Edit Delete	Restriction Requirement	10/08/2008	905	231	
Edit Delete	Restriction Requirement Response Received at PTO	12/05/2008	963		
Edit Delete	Non-Final Office Action	02/11/2009	1,031		
	3 Year Period Starts	04/17/2009	1,096		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	05/11/2009	1,120		
Edit Delete	Final Office Action	06/19/2009	1,159		
	Final Office Action + 3 months	09/19/2009	1,251		
	3 Year Period Paused	12/15/2009	1,338	242	
Edit Delete	Notice of Appeal Received at PTO	12/16/2009	1,339		88
Edit Delete	Final Office Action Response Received at PTO	12/16/2009	1,339		
Edit Delete	Advisory Action	01/12/2010	1,366		
Edit Delete	Final Office Action Response Received at PTO	06/22/2010	1,527		
	3 Year Period Resumed	07/22/2010	1,557		
Edit Delete	Notice of Allowance	07/23/2010	1,558	(220)	
Edit Delete	Issue Fee Paid	10/21/2010	1,648		
Edit Delete	Patent Grant Date	11/30/2010	1,688	(131) 350	
			Totals:	823	88
			PTA:	735	

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Version: 3.02.10

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IP: 10.14.44.154

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1/25/2011